

REMARKS

Claims 1-20 were originally presented in the present application, and claims 1-20 remain pending.

Reconsideration of the application is respectfully requested in view of the following responsive remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

In the office action of August 20, 2004, the following actions were taken:

- (1) Claims 1-20 were rejected under 35 U.S.C. § 112, first paragraph, as introducing new matter and failing to comply with the written description requirement;
- (2) Claims 1-20 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention;
- (3) Claims 1-20 were rejected under 35 U.S.C. § 102(b) as being anticipated by Haigh et al (U.S. Patent No. 3,999,653, hereinafter "Haigh");
- (4) Claims 1-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hacikyan (U.S. Patent No. 6,530,472, hereinafter "Hacikyan '472");
- (5) Claims 1-20 were rejected under 35 U.S.C. § 102(b) as being anticipated by Kreutz et al (U.S. Patent No. 4,213,528, hereinafter "Kreutz");
- (6) Claims 1-20 were rejected under 35 U.S.C. § 102(b) as being anticipated by Shantz et al (U.S. Patent No. 4,948,642, hereinafter "Shantz"); and
- (7) Claims 1-20 were rejected under 35 U.S.C. § 102(b) as being anticipated by Hacikyan et al (U.S. Patent No. 5,984,087, hereinafter "Hacikyan '087").

It is respectfully submitted that the presently pending claims be examined and allowed. Applicants submit that each and every amendment herein, and throughout the prosecution of the present application is fully supported by the specification as originally filed, and that no new matter has been added.

Rejection Under 35 U.S.C. § 112

Claims 1-20 were rejected under 35 U.S.C. § 112, first paragraph, for i) introducing new matter, and ii) failing to comply with the written description requirement. Specifically, the Examiner stated that the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention, and therefore constitutes new matter. The Examiner has also stated that it is not clear from the specification what the applicant intends by “an integrated device.”

Claims 1-20 have also been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. As both the first paragraph and second paragraph rejections stem from the same amendments, they will be discussed together herein.

To begin, using claim 1 as an example, the following is a summary of the claim elements still pending that have been added to the independent claim language over the course of prosecution.

1. (Currently amended) A protective container for containing a material and protecting against adverse exposure to the material, comprising:
 - a) a durable outer casing;
 - b) an inner casing being:
 - i) less durable than the outer casing;
 - ii) unreactive to the material; and
 - iii) configured to be a barrier in direct contact with the material, the outer casing and the inner casing being coupled together, and
 - c) a layer of a preventative agent disposed between the inner and outer casings which is sufficient to disable at least a portion of the material upon failure of the inner casing.

With respect to the new matter rejection, it is unclear which of these amendments provides the source of this rejection. As such, to remove these rejections once and for all, each amendment will be discussed. The Applicants assert each and every one of these amendments is directly supported by the specification, and thus, is not new matter. The phrase “unreactive to the material” is directly supported on page 7, lines 18-21, which states “Specifically, since the inner casing is in direct contact with the contents of the container over a large surface area, the inner casing must be made of a material which is unreactive with the container’s contents [i.e. material], and which does not become degraded or weakened by contact therewith.” The phrase “configured to be a barrier” is directly supported on page 5, lines 12-15, which states “As used herein, “inner casing” or “container lining” may be used

interchangeably and refer to a barrier in direct contact with the contents of a container [i.e. material], which is placed between the contents of the container and an outer casing of the container. Finally, the phrase “the outer casing and the inner casing being coupled together” is directly supported on page 8, lines 17-19, which states “In such a case, the outer casing 15 and the inner casing 25 are coupled together in some manner, allowing the container to be an integrated device.” The independent claims have been amended very carefully to reflect the language found in the specification. The Applicant has made every effort to amend the claims to be precisely consistent with the teachings and language of the specification, and yet the Examiner continues to issue 35 U.S.C. 112 rejections based on the Applicants amendments. The Applicant requests that this rejection be withdrawn, or alternatively, that a full explanation be given as to why the amended elements of the independent claims constitute new matter.

The Examiner has also stated that the phrase “an integrated device” does not satisfy the written description requirement under 35 U.S.C. 112, first paragraph. The Examiner has also stated that the term “integrated device” does not does not satisfy the requirements of 35 U.S.C. 112, second paragraph. In response to both of these rejections, as this limitation is not believed to be necessary for patentability, this term has been removed from the claim language. It is believed that the language requiring that the inner casing and the outer casing be “coupled together” is sufficiently distinct language to distinguish the claimed invention from the prior art, as will be discussed more fully below.

With respect to the objection related to claiming of the subcombination of the protective container or the combination of the protective container and the material contained therein, it is the Applicant’s intention that the subcombination is what is claimed. The Examiner should note the claims provide phrases such as “configured to” and “sufficient to” when referring to the material. These phrases denote that the material is not claimed *per se*, except to the extent that the material is related to the claimed structure. For example, the inner casing structure is described as “configured to be a barrier in direct contact with the material.” Likewise, the preventative agent disposed between the inner and outer casings is described as being “sufficient to disable at least a portion of the material upon failure of the inner casing.” This language makes it clear that the Applicant is claiming the structure of the container, and not the combination of the material and the container. Reconsideration of this rejection is also requested.

Rejection Under 35 U.S.C. § 102(b) and 103(a)

The Examiner has rejected claims 1-20 under 35 U.S.C. 102(b) as being anticipated by Haigh. It is Applicants' assertion that Haigh fails to teach each and every element of the claim language. Specifically, the Examiner has stated that "[t]he inner casing of Haigh is considered to be coupled to the outer casing to form an integrated device to the extent the requirement can be understood, and since they can in any event be described as being 'integrated.'" In light of this, all reference to the term "integrated" has been removed from the claim language in order to refocus the Examiner on the more applicable phrase "coupled together." A first container resting within a second bag or container is not an example of two objects that are coupled together. The Applicant has gone to great lengths in the previous office action response explaining that the glass container in Haigh, which contains the liquid, is clearly independent of the package in which the glass container is placed. Haigh only teaches that an outer container is used to carry the glass vial. There is no teaching or suggestion therein that the glass vial is coupled to the outer packaging structure. Without a physical coupling, it cannot be said that Haigh teaches each and every element of the claimed invention.

Further, to avoid any further confusion, the independent claim has also been amended to include "consisting essentially of" language. Such language would exclude the Examiner from considering any container system having an intervening layer between the inner casing and the outer casing other than the one or more layer(s) of preventative agent. In other words, the inner casing and the outer casing are coupled together, and the preventative agent layer(s) is disposed therebetween. Any device that includes additional layers between any two of these three layer types would be excluded from the claim language explicitly. Further, any system that does not include the inner and outer casing being coupled together would also be explicitly excluded from the claim. This amendment further distinguishes the teachings of Haigh from the claimed invention. Withdrawal of this rejection is respectfully requested on these grounds.

As a note, support for the "one or more" language can be found in the FIGS., where a single preventative layer embodiment is shown in FIG. 1, and a multiple preventative layer embodiment is shown in FIG. 2.

The Examiner has also rejected claims 1-20 under 35 U.S.C. 103(a) as being unpatentable over Hacıkyan '472. It is Applicants' assertion that it would not be obvious in light of Hacıkyan '472 to provide a container in which inner and outer casings are disposed

about a preventative layer, with i) the inner casing being unreactive to a material to be contained, ii) the inner and outer casings being coupled together, and iii) the inner casing being a barrier to the material.

Similar to Haigh, Hacikyan '472 teaches of a safety container for shipping or storing independent vials containing hazardous materials. A vial 108 contains the material and is stored within an outer container 100 that includes a fluid soluble liner 112 that covers a lining 100 protected by an outer, impermeable wall 102. The outer container 100 is adapted to ship or store the vial 8, as discussed in col. 3, ln. 28-29. Thus, as in Haigh, the Hacikyan '472 device is a protective vessel adapted to receive a separate container of hazardous material, not a single container for receiving the material. In other words, in order for Hacikyan '472 to read on the present claims, the vial of Hacikyan '472 must be analogized to be the "inner casing," as the claim requires that the inner casing be a barrier in direct contact with the material. No other structure in Hacikyan '472 would satisfy this claim element. Thus, as the vial is not coupled to any other structure, Hacikyan '472 does not read on the claimed invention. In other words, the container claimed in the present application requires at least three layers: an outer casing, an inner casing, and a preventative agent disposed between the outer and inner casing. The outer casing and the inner casing are coupled to each other with the preventative agent disposed therebetween and the inner casing acts as a barrier that is unreactive to a material being contained. Thus, the present container provides a storage container that protects against adverse exposure to the material stored therein. No structure or combination of layers in Hacikyan '472 reads on each of these elements. Further, the inclusion of the "consisting essentially of" language in the claims further distinguishes this claim from the teachings of Hacikyan '472, as the presence of an intervening layer (Layer 112) between the vial and the preventative agent is necessarily present in Hacikyan '472. Reconsideration on these grounds is respectfully requested.

Other relevant arguments have previously been presented with respect to Haigh and Hacikyan '472 which are still relevant, and which appear to have not been fully considered. To the extent that these arguments remain relevant, they are incorporated herein by reference. The Applicant urges the Examiner re-review the most recently filed office action response for these arguments.

The Examiner has also cited three additional references as being anticipatory of the presently claimed invention. Specifically, claims 1-20 were rejected under 35 U.S.C. § 102(b) as being anticipated by each of Kreutz, Shantz, and Hacikyan '087. These references

are less relevant than those discussed above. However, to be complete, the Applicant will briefly address each individually.

Kreutz teaches of a package for an acid container. The package includes an acid resistant envelope 11, a sealed end 12, an open end 13, an acid neutralization absorbent shield 14, and a closure member 17. The purpose of this invention is much like that of Haigh and Hacikyan '472, i.e. to protect a glass vial placed therein. Like the other references, the glass vial is not coupled to the package. The glass vial merely sits loose in the package. Thus, Kreutz is inapplicable to the claimed invention for many of the same reasons that Haigh and Hacikyan '472 are inapplicable. Reconsideration on these grounds is respectfully requested.

Shantz teaches of a multiple layer container having a three layer wall. The three layer wall includes an inner layer 18, an outer layer 19, and a tie layer 20. The inner layer is of an appropriate material that is resistant to the high purity and highly reactive chemicals being stored. See col. 3, ln. 29-31. The outer layer serves as a structurally reinforcing layer to prevent the inner layer from being damaged or ruptured during storage or transport. See col. 3, ln. 52-54. The tie layer is utilized to bind the inner layer to the outer layer. See col. 4, ln. 5-6. There is nothing in Shantz that teaches the tie layer can act as a preventative agent as required by the claim. The tie layer is merely selected to be of a material to adhere the outer layer to the inner layer. Thus, this reference is less relevant than the other references cited. Withdrawal of this rejection is respectfully requested.

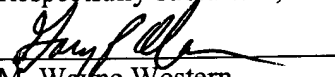
Lastly, Hacikyan '087 is no more relevant to the claimed invention than Hacikyan '472. Again, this reference teaches of a container for carrying a vial. As such, the same analysis as applied to Haigh and Hacikyan '472 described above also apply to this reference. Reconsideration is respectfully requested.

In view of the foregoing, Applicants believe that claims 1-20 present allowable subject matter and allowance is respectfully requested. If any impediment to the allowance of these claims remains after consideration of the above remarks, and such impediment could be removed during a telephone interview, the Examiner is invited to telephone David W. Collins at (520) 399-3203, so that such issues may be resolved as expeditiously as possible.

Please charge any additional fees except for Issue Fee or credit any overpayment to
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Respectfully submitted,


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